IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No. 671

AUBREY A. LARSEN, *Petitioner,*

v.

DAVID L. LADD, Commissioner of Patents, *Respondent.*

On Petition for a Writ of Certiorari to the United States Court of Customs and Patent Appeals

REPLY BRIEF FOR PETITIONER

Petitioner wishes to reply to certain inaccurate statements in the Brief for The Respondent In Opposition filed by the government.

I. In the three different places in the government brief a statement is made to the effect that petitioner's process claims do not possess novelty. These statements are:

government brief—p. 6:

"The contention advanced by petitioner—that whenever a product is patentable the method by

which it is made is also patentable regardless of the novelty of the method—is refuted by many decisions of this Court and the lower federal courts."

government brief—p. 6-7:

"In the present case, both the Patent Office and the Court of Customs and Patent Appeals found as a fact that petitioner's process claims did not possess novelty. This the petitioner does not dispute, but merely relies on the novelty of the product."

government brief—p. 9:

"Certainly, this does not support the contention that process claims, lacking novelty, are patentable merely because the resulting product is patentable."

The above-quoted statements from the government's brief are flatly incorrect. Petitioner's process claims are novel. If they were not novel, then the claims would be statutorily barred under 35 U.S.C. Section 102, and petitioner would never have troubled this Court. The Court below expressly recognized that petitioner's process was novel. Thus, Judge Rich's concurring opinion says, at Appendix to Petition, p. 6a: *"Novelty,* we have, * * *"

The government brief completely misses the point by confusing "novelty" (35 U.S.C. 102) with "unobviousness" (35 U.S.C. 103). A claimed process either is novel or it is not. Here it is novel.

The sole question is whether the claimed process is sufficiently unobvious to be "inventive" under 35 U.S.C. Section 103. Petitioner relies strongly on the finding that the product which is made by his novel

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process is patentable (i.e. novel, useful and inventive) because this legal conclusion is bottomed on facts, already established, which facts also establish the patentability of the claimed process, even though the latter be viewed separately. A rough analogy might be made to the situation where two individuals are charged with conspiring with each other to commit a crime. If one be found not guilty, this establishes that the other is not guilty. So here, while the invention of the product and the invention of a process for its production may not be absolutely coextensive, they have elements in common, the establishment of which renders both patentable.

II. The government brief makes an erroneous statement at p. 9 where it says:

> "Moreover, the legislative history of 35 U.S.C. 103 refutes the petitioner's assertion that the section was designed to change prior law and cause allowance of claims that had previously been disallowed."

Petitioner does not say the law has been changed, so claims to which he would not have been entitled under prior law should now be allowed. His assertion is just the opposite, i.e. that he is being refused claims which would have been allowed by the Patent Office as a matter of course under prior law. See the printed Transcript of Record at p. 24, where the Patent Office Board of Appeals said in its opinion:

> "We are well aware of the fact that in many cases of this type the process claims have been allowed almost as a matter of course along with the product claims . . . ."

Petitioner says 35 U.S.C. section 103 did not change the prior law as previously interpreted and understood by the Patent Office and the patent bar in this respect, and that it was error for the Court below to apply the statute as it did.

There now exists a serious controversy as to the correctness of the government's view that 35 U.S.C. Section 103 is a mere codification of existing law, as shown by the opinion of Judge Learned Hand in *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530, 535 (C.A. 2) cert. denied, 350 U.S. 911. This is another reason why certiorari ought to be granted in this case.

III. The government brief at p. 7 quotes from *Rubber Company* v. *Goodyear*, 9 Wall. 788, 796 to the general effect that process claims and product claims are separate and independent with respect to patentability. While this proposition is generally true, this court recognizes an exception as is pointed out at p. 11 of our Petition, where, as here, a new process produces a new (chemical) substance.

Respectfully submitted,

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